tion in that country for several years, he introduced it into the markets of the United States. When he did so he elected not to apply for a United States patent, but to rely solely upon the protection of the name, "Rahtjen's Composition," under which he specifically required that it should be sold (Record, p. 298, Ex. Q.). Its reputation at once became established in this country, where it has ever since been sold by the Rahtjens and their successors down to and including this respondent. Four years after the establishment of this agency and trade-mark, and after the property right in the trade-mark had become fully established by the acts of the Rahtjens and their agent, a patent was secured in England for a formula used in the manufacture of one variety of the paint, which patent lapsed seven years later. Some years thereafter the petitioner, a manufacturer of and dealer in other paints, began the sale in the United States under the name of "Rahtjen's Composition" of a paint made by it in England. As soon as this became known to the respondent, it commenced this suit, wherein the Circuit Court of Appeals has sustained respondent's claim of exclusive right to the trademark, and has enjoined its further use by the petitioner.

It is now sought to have the proceedings of the Circuit Court of Appeals reviewed by this Court.

We respectfully submit that it is impossible to spell out of these facts any grounds sufficient to call for the interposition of this Court. Those suggested in the petition are clearly without foundation. We shall consider them briefly in the order in which they are recited.

PETITIONER'S POINTS.

I.

Paragraphs 1 to X of the petition recite the proceedings. In Paragraph XI it is said, "That the judgment and decree is erroneous" The petition shows that the exact form of the order of the Circuit Court of Appeals was prepared by, and entered on motion of, counsel for petitioner. (Petition, p. 19). It cannot complain of an action of the Court taken at its own request. Whatever has been done has been done at its solicitation. It now seeks to have that action reviewed under "a power which will be sparingly exercised" We submit that the petitioner has thus waived any right to further action, and that the respondent need go no farther.

Our understanding is that if this petition be granted the case will be treated by this Court exactly "as if it had been carried (here) by appeal" (26 St. at L., §6, p. 828).

The rule is plainly stated by Mr. Justice Gray, speaking for a unanimous Court, in Nashville, etc., R. R. Co., 113 U. S., 261, 266:

> "But the unsurmountable difficulty is, that the former decree appears upon its face to have been rendered by consent of the parties, and could not, therefore, be reversed, even on appeal. Courts of Chancery generally hold that from a decree by consent no appeal lies (2 Dan. Ch., Pract Ch. 32, §1; French v. Shotwell, 5 Johns, Chap. 555; Winchester v. Winchester, 121 Mass., 127). Although the rule has not prevailed in this Court under the terms of the acts of Congress regulating its appellate jurisdiction, *yet a decree which appears by the record to have been rendered by consent is always affirmed, without considering the merits of the cause.*" [Italics ours.]

To the same effect are:

U. S. v. Babbitt, 104 U. S., 767.
Evans v. Phillips, 4 Wheat., 73.

U. S. v. Evans, 5 Cranch, 280.
Central Transportation Co. v. Pullman's Palace Car Co., 139 U. S., 24, 39.
Pacific R. R. Co. v. Ketchum, 101 U. S., 289.

A fortiori, a decree entered upon the motion of a defeated party must be affirmed.

To grant the petition, therefore, can have no result beyond causing the parties the expense, and the Court the labor, of considering here a decree of a kind "always affirmed without considering the merits of the cause"—a result very barren, and, we submit, foreign to the purpose of the act under the provisions of which this petition is made.

Therefore, it avails nothing that the petition emphasizes the magnitude of the Court's power. It can, notwithstanding the state of the record, bring the cause before the Court for review; but the record shows conclusively that when the cause is brought before it, there will be nothing to consider.

II.

The second ground suggested for the interposition of this Court is found in paragraph XII.

> "The said case was decided in the said United States Circuit Court of Appeals for the Second Circuit, upon the supposed recognition of the said doctrine by this honorable Court in the case of the Singer Mfg. Co. v. June Mfg. Co., 163 U. S., 169, but the question presented by and involved in the said case of the petitioner was not presented by or involved in the case of the Singer Mfg. Co. v. June Mfg. Co., &c."

This, we say, with the greatest respect for the learned gentlemen on the other side, is baldly

fictitious and misleading. The Court of Appeals in this case says:

> "The Singer case, *supra*, had exclusive reference to the continuance of a monopoly in this country, upon which letters patent of this country had expired, and the Court held that the right to use the name passed to the public in this country, with the expiration of the exclusive right created by the patent, to make and sell the article. The decision followed the previous general course of decisions in the Courts of this country and elsewhere, *but it did not relate to the facts of this case*, as obviously appears in the opinion of Mr. Justice White who spoke for the Court" (Opinion of Court of Appeals, Petition, pp. 13, 14).

In other words, the petitioner says, and, in substance, reiterates in Paragraph XIII, that the Singer case had no relevancy to the present facts, the respondent so contended, and the Court so decided. All, then, are agreed that the Singer case has no application to the present. To bring it forward in order to induce this Court to exert "a power not ordinarily to be exercised" is a confession of weakness.

III.

In Paragraph XIII it is urged

> "That the question whether a common law trademark in the name of an article, is or is not affected in this country by the expiration or lapse of a foreign patent on said article, has never been judicially determined by any Court, prior to the said suit against your petitioner."

It would seem that something more than that the case be one of "first impression" is required before this Court will interpose in a case of a class wherein the judgment of the Court of Appeals is

made final by the act of Congress. There is here nothing more than the novelty of the question to call for this Court's interposition. Up to the present time it certainly has been of no "gravity and importance." To ask the Court to provide for the future when the past indicates that it is unnecessary, is to ask it to reverse the ordinary course of judicial determination and to change a jurisdiction which, we submit, was intended by Congress to be primarily corrective, into a jurisdiction essentially legislative.

If the Courts in different circuits had disagreed on this question of law, then there might be some basis on which to argue that the Supreme Court should consider and settle the question, but the mere fact that the question is new and has arisen but once is not a basis for a review by it. For if this Court should hold that it ought to review the question merely because it has not arisen before, the Circuit Courts of Appeals would have final jurisdiction only upon questions that had actually been settled by the Supreme Court, and they would so become merely ministerial in their functions.

Furthermore, if it be assumed that the question suggested is of importance, the determination of this case can do little to settle it. It has been said many times by many courts that each trade-mark case necessarily stands alone. This is strikingly true in the present instance. The paint was sold for four years in the United States before the English patent was applied for. The fact that the domestic trade-mark long antedated the foreign patent is a circumstance so important and so exceptional that this case is readily distinguishable from every case that has arisen or, in all human probability, will ever arise. Whatever may be the importance of the broader question suggested in the petition, the question involved in this case is important only to

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the parties. We submit therefore, that even if the question suggested requires the consideration of this Court, such consideration should be given in some other case where its answer is called for by the facts, and may be plain and unmistakable.

IV.

The petitioner also urges the interposition of this Court because it

> "Will be forever enjoined from using the word 'Rahtjen,' thereby ending an established business which it has built up through very many years."

The severity or breadth of the decree and the injunction founded thereon is not open to criticism or objection by the petitioner, for the reason that their precise form and scope were fixed by the order which petitioner's counsel prepared and submitted to, and which was approved by, the Court of Appeals.

V.

The petitioner wholly fails to make a case within the limitations which this Court has defined, and by which its discretionary action is determined. We understand that it is the policy of the Court to grant petitions of this character only in the cases which fall within the exceptions noted in Forsyth vs. Hammond, 166 U. S., 506, 514. Namely; where a question of great importance is involved; where there is a conflict between two or more Courts of Appeals or between a Court of Appeals and the courts of the State; or where there is some matter involved affecting the interests of the nation in its internal or external relations. Let us test the petitioner's case by this rule.

First. There is no question of great importance involved. The only parties in interest or in any way concerned in this controversy are the petitioner and respondent. The rest of the world is absolutely indifferent. It is not a case even where there is a great number of users of the name, all of whom will be affected by a decision as to one.

The record does not show that there is any other person who will be affected by the decision, and there is no allegation to such effect in the petition for certiorari.

Counsel for petitioner claim that if the present decree and injunction stand, its "established business built up through very many years," will be destroyed. This is not borne out by the facts in evidence. It appears that the defendant's business was established for, and for years confined to, the manufacture and sale of other paints than so-called "Rahtjen's Composition"; that the business which it has done in Rahtjen's Composition has always been of minor importance and subordinated to its business in its chief brand, "International Composition." The Court of Appeals on this point says:

> "It manufactures and sells other paints, the leading brand being called the 'International' which kind it makes special effort to sell. The business of the defendant in the United States from 1890 to 1895, including a few small invoices sent to different persons from 1883 to 1890, amounting to about 92 cwt., was a fraction over 2152 cwt." (Petition, pp. 11, 12).
>
> "It is true that the defendant has sold its manufacture of Rahtjen's Composition to a certain extent since 1890, but the sales have been comparatively small, and did not interfere with the complainant's business to any marked extent until the defendant obtained the contract with the Navy Department of the U. S. Government in answer to a call for offers of Rahtjen's Composition, when suit was promptly commenced. The defendant's

> chief brand of paint is the 'International Composition' and it has been their endeavor to sell that brand, if they could, and, failing that, Rahtjen's Composition. * * * The defendant's interference with the property rights of the plaintiff was, for many years, inconsiderable" (Petition, p. 15).

The defendant can be subjected to no loss whatever as to the past because there is no accounting in damages. The only detriment to which it can possibly be subjected is being prevented from making sales of Rahtjen's Composition to parties demanding it in preference to the petitioner's own brand, viz.: "International;" or, in other words, from selling to the customers of the respondent instead of its own. Its legitimate business can in no wise be affected by the present decree and injunction.

Second. The petition for certiorari alleges no such conflict of decision.

Third. It is evident that the issues involved have no import of a national or international character, and there is no allegation to that effect.

VI.

A close analysis of the case shows that the petitioner is aggrieved, not by reason of the application of the law, but the lack of facts to support its claims and requirements. Such a difficulty this Court in its discretion does not attempt to relieve by a review of the proceedings of the Circuit Court of Appeals. It may be said also that the difference between the judges who heard this case in the Circuit Court and in the Circuit Court of Appeals, is one merely of fact and not of law. Two contentions have been made

by the petitioner in its pleadings, in the taking of evidence, and in the trials below, both of which are upon questions of fact and constitute the points of difference between the judges who have heard this case.

The first is, that prior to the application for the English patent in question there had been no such use of the name "Rathjen's Composition" as to establish a common law property right in it. Counsel for petitioner in the Court of Appeals spoke of such use as merely "experimental," and tried to minimize the effect of the proofs.

The other point and contention are, that the name "Rathjen's Composition" has lost its original function of indicating the source or origin of the goods to which it has been applied, and has become generic and descriptive in character, irrespective of the legal effect of the lapse of the foreign patent.

On the first point it is to be noted, that the sales of Rahtjen's Composition in the years 1870–1873, inclusive, in the United States, amounted in value to nearly $10,000 (see testimony of John Rahtjen, p. 219, Appeal Record). The figures given by the agent (Gelien) during those years are somewhat less, but the difference is not material to the question under consideration. The evidence as to the sales in this country year by year also shows that the business was continuous and uninterrupted. These facts therefore fully sustain the majority of the Court of Appeals in finding that a common law trademark right had become established in the United States prior to November, 1873, the date of the English patent. On the other hand, they do not sustain the conclusion of Judge Wheeler in his decision in the Circuit Court, that

> "Rahtjen's Composition appears to have become a valuable article of commerce, well-known by that name throughout the maritime

> world through Rahtjen's expired English patent and his operations under it" (see page 3 of Petition).

Neither does it support the conclusion of Judge Wallace in his dissenting opinion, that

> "The name (Rahtjen's Composition) was the generic description of a patented article and passed to the public on the expiration of the patent,"

because the meaning of both statements is that the name commenced with, and owed its existence to, the patent.

The second point is, that the name "Rahtjen's Composition" had, in the language of the dissenting opinion of Judge Wallace,

> "long ceased to denote the source of the manufacture of the article."

This of necessity presupposes and presumes that there must have grown up numerous sources of supply for the article. If there were one source only no such impression could prevail. It is proven conclusively and without a particle of evidence to the contrary, that during all of the thirty years in which Rahtjen's Composition has been continuously sold in this country there has been but one authorized source from which it could be obtained. This source until 1879 was the factory of the firm of John Rahtjen, in Germany; for a year or two thereafter the factory of the same firm in England; from 1880 to 1891 the same factory, which had been transferred by the firm John Rahtjen to the firm of Hartmann Brothers and their successors, the English corporation of Suter, Hartmann & Rahtjen's Composition Company; and since 1891, the complainant corporation, the successor and offshoot of the English corporation. During all of this period also the agency in the United States has been a sole and

exclusive one; first, of Henry Gelien, representing the firm John Rahtjen until 1877; then Hartmann, Le Doux & Maecker, representing said firm and their successors in England until 1886; then Emil Maecker, a former member of said firm of agents, until 1889; then O. L. Petersen, until the organization of the complainant company. Further, there never has been but one *unauthorized* source for Rahtjen's Composition, and that the defendant, to a limited extent, immediately preceding the commencement of the suit.

We submit that these facts cannot sustain the contention of petitioner that the name "Rahtjen's Composition" had become dissociated from the origin of the goods so marked, and the majority of the Court of Appeals is fully justified in its conclusion viz:

> "We are not able to find from the record as a fact that in the United States the name 'Rahtjen's Composition' has become a generic name, and now means a composition made by any one after the original formula of Rahtjen" (Petition, p. 15).

The claim by petitioner that the trade-mark no longer suggests the origin of the goods because the petitioner itself, for the avowed purpose of securing respondent's customers, had provided a second source, is an offensive attempt to profit by its own wrong.

It may be noted also that during all of the thirty-five years of continuous sale of Rahtjen's Composition, first in Germany and later in the United States, the brothers Rahtjen have been directly interested in the business; first, as the manufacturers under the firm name of John Rathjen, afterwards as licensors under a royalty contract, and then as stockholders in both the English and American Companies, both of which companies employ as part of their corporate names, the surname "Rahtjen."

These facts, on both the points in question, justify the conclusions of the majority of the Court of Appeals, and it is fair to assume that had the facts been viewed in like manner by the dissenting member of the Court of Appeals, and by the judge in the Circuit Court, they would have reached a like conclusion upon the merits of the case.

VII.

It is significant that only one case is cited by the Court of Appeals, viz.: Le Page Company vs. Russia Cement Company (51 Fed. Rep., 941), and this solely in reference to the right of succession to the trademark, a question not herein involved.

The only other case referred to, that of Singer Mfg. Co. vs. June Mfg. Co., 163 U. S., 169, the Circuit Court of Appeals holds not applicable to the case at bar. In other words, upon the facts found, that Court merely states that a prior existing, domestic, common law trade-mark is not affected by a subsequent foreign patent on the thing sold under the trade mark. The decision goes no further than the particular facts of the case require, and no attempt is made to lay down any general rule of law applicable to any other than these anomalous facts.

Petitioner's "Claims."

Counsel for petitioner, after briefly stating its grievances and the reasons why relief should be afforded it, very adroitly present certain questions not involved herein, and their claim as to the rule of law applicable thereto.

We do not understand that it is the function of this tribunal to act as a moot court, or to command

that a cause be remitted to it merely for the opportunity thereby afforded to adjudicate questions purely hypothetical and speculative in character. We submit that to request such action is presuming upon the discretion of this Court. In the apt language of Chief Justice Church in the case of Guest v. Brooklyn, 69 N. Y., 513:

> "Courts have commonly occupation enough in determining controversies which have become practical without spending time in hearing discussions respecting such as are merely speculative or potential."

Any other rule would tend to make the granting of writs of certiorari depend in large measure on the fertility of counsel's imagination, and their skill in framing attractive abstract questions.

We briefly note the various "claims" of petitioner's counsel, and call the Court's attention to their lack of pertinency to the case at bar.

The FIRST is—

> "That when a name under which an article has become known in the country in which it was patented becomes public property there by reason of the expiration of the patent, it becomes public property the world over (except in such countries where there may be valid existing patents unaffected by the term of the foreign patent)."

This is a question which has nothing to do with this case because it assumes what is not true, that the name was first applied to the patented article, ignoring the proof of the long prior existence of the trade-mark.

The SECOND "claim" is predicated upon the first and is also a question not in any way involved in this case.

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The THIRD "claim" that—

> "If the respondent ever acquired a common law trade-mark in the United States, such trade-mark became public property when the English patent expired,"

is not a fair statement of the facts, since it also implies no earlier adoption of the trade-mark than the date of the patent.

The FOURTH—

> "That the respondent cannot have a common law trade-mark in the United States in a name which has become public property abroad,"

is still further at variance with the facts herein. The statement of the "claim" implies that the mark in question was public property abroad at the time it was first used in this country, which is not true.

The FIFTH "claim"—

> "That the name 'Rahtjen's Composition' has become the generic description of a patented article, and passed to the public on the expiration of the patent,"

is not pertinent for two reasons. It implies that the name "Rahtjen's Composition" is the generic description of an article previously covered by a domestic patent, whereas, there never was a domestic patent, and the name was in extensive use the world over for years before the foreign patent.

The SIXTH "claim"—

> "That the name 'Rahtjen's Composition' has long ceased to denote the source of manufacture,"

has already been discussed, and is simply a

question of fact which has been adversely decided by the Circuit Court of Appeals.

The SEVENTH "claim" is in effect that respondent has been guilty of such laches as to be barred from any relief. This also is a question of fact which has been passed upon by the Circuit Court of Appeals, and all the advantage which, under the established rule, is possible has been gained by the petitioner in the denial to the respondent of any accounting in damages. This is not a question proper for this Court to review, and we repeat that the statement of fact is not justified by the evidence in the case since the chief "established business" of the petitioner, according to its own witnesses, has never been in "Rahtjen's Composition" but others.

The EIGHTH "claim" is based upon a question of pure fact which the Circuit Court of Appeals has carefully considered and answered, and counsel for petitioner merely take issue with its finding.

The NINTH "claim" is based upon evidence of certain acts of the English corporation which owned the trademark rights in this country and transferred them to respondent, as to its rights in England. Nothing appears in the record giving to those acts extra-territorial force or effect to the prejudice of established property rights in this country.

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The Law.

But assuming that petitioner's counsel in their brief shall present arguments more forcible than the points of their petition, let us consider briefly the real question in the case and the analogies or guides which may be found in the decisions of this and other Courts.

This question is narrow, and in its consideration by the Court below, there has been no departure from, but a strict adherence to, the legal principles recognized by this Court and the Circuit Courts of Appeals. The Circuit Court of Appeals here holds that the Singer case is not applicable to, and does not govern, this case.

In the Singer case, the effect of the expiration of a domestic patent upon the trade monopoly in a name which had been applied to the patented article, was considered. This Court, in holding that the trade monopoly in the name ended with the patent monopoly, noted with approval exceptions to that rule in decisions of certain courts in foreign countries where patents had never issued on the article (see Petition, page 14). It is fair to assume and infer from the language of this Court in the Singer case, that if the conditions had been reversed, viz., had Singer secured foreign patents but no domestic patent on the article, the decision would have accorded with those of the foreign courts referred to. It is a fair deduction also that this Court would have held a case such as the present an exception to the established rule.

By the very respectable authority of the Court of Appeals of the First Circuit, in the case of Atwood vs. Castner, 88 Fed. Rep., 642, an exception is recognized to the general rule that a geographical name cannot be

appropriated as a trademark, where it appears that the name has become established and recognized as a trade name before its adoption in a geographical sense to designate the locality of such use, and hence such subsequent adoption could not affect the established property right in the name.

Still closer analogy is found in a case recently decided by the Circuit Court of Appeals of the Second Circuit (Batcheller vs. Thompson, 93 Fed. Rep., 660). In that case a domestic patent was used in connection with a trademark antedating the patent by two and a half years. The Court held that case an exception to the Singer rule solely because the trademark antedated the patent.

The exception noted by this Court in the Singer case, and the reasoning and findings of the Courts in the other cases above noted, are all in harmony with each other and with the decision of the Circuit Court of Appeals in this case. Not only is the decision of the Circuit Court of Appeals herein in harmony with the others noted, but this case is narrowed by the facts heretofore stated, that the trademark was established in this country with the avowed purpose at the time of seeking no patent in this country, sole reliance for protection being placed on the name under which the goods were required to be sold, and that the only patent involved was a foreign one applied for years afterwards. It is not necessary for us to call the attention of this Court to the analogy of the rule in patent cases universally recognized and followed by the courts in this country also.

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Conclusion.

On all the facts in the case, why should the Court grant the writ? If this petitioner on this showing can successfully appeal to the discretion of the Court, any defeated litigant in the Court of Appeals can with equal assurance present a like petition. We submit that no reason has been shown why this Court should depart from the wise rule by itself laid down in Forsyth vs. Hammond, noted above.

The petition should be denied.

New York City, May 10, 1900.

Respectfully submitted,

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